

Atty Dkt. No.: 10981377-4
USSN: 10/020,693

REMARKS

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 37 -43, as well as newly added claims 46-72, the only claims pending and currently under examination in this application.

The abstract has been amended to change the word "comprising" to "having." Claim 37 has been amended to incorporate that the phase reversible material is stably associated with the micro-valve. Support for this amendment can be found in the specification at page 9, lines 16-19. In addition, new Claims 46-72 have been added, where support for these new claims is found in the originally filed claims. As no new matter is added by the above amendments, entry thereof is respectfully requested.

To address the observation raised by the Examiner on page 2 of the action, the abstract has been amended to remove the word "comprising."

Claims 37-43 were rejected under 35 U.S.C §102(b) as being anticipated by Burns et al. (U.S. Patent No. 6,048,734).

It is noted that, since Burns issued after the priority date of the present application, it actually is 102(e) art to the present application, and not 102(b) art.

Under current case law, a reference does not anticipate a claim unless "all of the elements and limitations of the claim are found within [that]...reference.... There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of invention." *Scripps Clinic v. Genentech, Inc.*, 18 USPQ2d 1671, 1672 (Fed. Cir. 1992).

The rejected claims all require the presence of a phase reversible material that is stably associated with a micro-valve. Specifically, Claim 37 as amended recites a micro-fluidic device having a fluid flow path and at least one micro-valve comprising a phase reversible material stably associated with the micro-valve.

Atty Dkt. No.: 10981377-4
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Burns et al. fail to disclose a phase reversible material that is stably associated with a micro-valve. Instead, Burns et al. disclose a meltable material that flows (column 6, lines 1-13; column 24, lines 9-12). As such, the meltable material of Burns et al. cannot be stably associated with a micro-valve because it flows or moves within the device. Consequently, Burns et al. fail to teach a device with a phase reversible material stably associated with a micro-valve. Thus, the claimed invention differs from the Burns et al. method because the claimed method uses a device having a phase reversible material stably associated with a micro-valve and Burns et al. does not have a material stably associated with a micro-valve.

In view of the foregoing, Claims 37-43 are not anticipated by Burns et al. As such, the Applicant respectfully requests that the rejection of 37-43 under 35 U.S.C §102(e) over Burns et al. be withdrawn.

Atty Dkt. No.: 10981377-4
USSN: 10/020,693

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,

Date: 12-8-04

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